



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/875,460

06/05/2001

Dan Kikinis

ISURFTV136

6281

52940

7590

11/21/2006

TODD S. PARKHURST  
HOLLAND & KNIGHT LLP  
131 S. DEARBORN STREET  
30TH FLOOR  
CHICAGO, IL 60603

EXAMINER

SALCE, JASON P

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/875,460

Applicant(s)

KIKINIS, DAN

Examiner

Jason P. Salce

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-11, 14-19 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-11, 14-19 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see Applicant's Arguments, filed 9/25/2006, with respect to the rejection(s) of claim(s) 1-3, 6-11, 14-19 and 22-24 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Ellis ('208 Patent Application Publication) in view of Ellis ('926 Patent).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6-7, 9-11, 14-15, 17-19 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926).

Referring to claim 1, Ellis discloses receiving EPG selection entered over the Internet via a remote device (see Paragraphs 0014-0016).

Ellis also discloses storing the EPG selections on a storage device (see Paragraph 0072 for the remote program guide access device storing the EPG data).

Ellis also discloses transmitting the EPG selections to be displayed when requested (see Paragraph 0016 for making program selections remotely, which will be displayed on the TV).

Ellis is silent as to the EPG selection being entered via a web-enabled cellular phone.

Ellis ('926 Patent) discloses a cellular phone 42 with display 100, wherein the display 100 is used to display and select EPG items (see Column 7, Lines 18-26 and Column 8, Lines 60-67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to combine the systems of Ellis and Ellis ('926 Patent) in order to provide a system capable of utilizing a mobile phone having EPG capability as a remote controller, thereby providing the user with extended functionality and control and allowing the user to reserve programs from remote locations. Also note that Ellis ('926 Patent) specifically states that an advantage to the system allows the cell phone to access the schedule information and perform various functions, such as searching for programming of interest, establishing favorite programs, setting reminders and setting parental controls (see Column 1, Lines 40-46).

Referring to claims 2 and 3, Ellis discloses storing EPG selections on a broadcast server and set top box (see Paragraph 0017 and Figure 2).

Referring to claim 4, Ellis further discloses the remote terminal can be a PDA (see Paragraph 0092).

Referring to claim 6, Ellis further discloses that the system displays EPOG selection on the remote terminal when requested (see Paragraph 0015).

Referring to claim 7, in light of the combined disclosures used to rejection claim 6, claim 7 would be an obvious variant. Transmitting EPG data to multiple remote terminals is obvious in light of the disclosure of Ellis already teaching transmittal to one remote terminal.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the teaching of Ellis in order to provide multiple separate devices, thereby allowing multiple users to utilize the system concurrently.

Referring to claims 9-11 and 14-15, see the rejection of claims 1-3 and 6-7, respectively.

Referring to claims 17-19 and 22-23, see the rejection of claims 1-3 and 6-7, respectively.

3. Claims 8, 16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis

Art Unit: 2623

et al. (U.S. Patent No. 6,774,926) in further view of Terakado et al. (U.S. Patent No. 6,246,441).

Referring to claim 8, Ellis and Ellis ('926 Patent) disclose all of the limitations of claim 6, but are silent as to transmitting one or more programs to be separately displayed concurrently with displaying the EPG selections.

Terakado discloses (in the same field of endeavor) a similar system which is capable of allowing a user to view a program broadcast on the television while concurrently viewing the EPG data on the remote terminal (see Column 9, Lines 47-53).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the systems of Ellis, using the teachings of Terakado in order to provide a system capable of allowing a user to watch a broadcast program on the television receiver 9, while checking programs to be broadcast from a time onward by using an EPG without obstructing the display of the television receiver 9 (see Column 9, Lines 50-53 of Terakado).

Referring to claims 16 and 24, see the rejection of claim 8.

### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce  
Primary Examiner  
Art Unit 2623

November 16, 2006

JASON SALCE  
PRIMARY PATENT EXAMINER

A handwritten signature in black ink, appearing to read 'Jason Salce', with a long horizontal stroke extending to the right.